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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,141	01/27/2006	Bjorn Ove Dalseide	53550.78	1896
Francis C. Hand Carella, Byrne, Bain, Gilfillan, Cecchi, Stewart 5 Becker Farm Roseland, NJ 07068				
EXAMINER				
SALONE, BAYAN				
ART UNIT		PAPER NUMBER		
4151				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/566,141

**Applicant(s)**

DALSEIDE, BJORN OVE

**Examiner**

BAYAN SALONE

**Art Unit**

4151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 1/27/06.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7 and 8 is/are rejected.
- 7) ☒ Claim(s) 3-6 and 10-12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01/27/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date 05/02/2006
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 05/02/2006 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because it was not filed using the 1449 form. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Claim Objections***

2. Claims 3 and 9 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim may refer in the alternative to only one set of claims. Furthermore, a multiple dependent claim may not serve as a basis for any other multiple dependent claim, either directly or indirectly. These limitations help to avoid undue confusion in determining how many prior claims are actually referred to in a multiple dependent claim. See MPEP § 608.01(n). Accordingly, claims 3 and 9 will not

be further treated on the merits. The examiner suggests the applicant rewrite the claim as Claim 3. A device according to claims 1 or 2, characterized---

3. Claims 4-6 and 10-12 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, claims 4-6 and 10-12 will not be further treated on the merits.

***35 USC § 112 Sixth Paragraph***

4. The following is a quotation of the sixth paragraph of 35 U.S.C. 112:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

5. In regards to Claim 1, Dalseide (US Patent Application No. 10/566141), discloses a connecting means which each is in the form of a relatively short length of chain, piece of wire or similar flexible connecting means. The examiner interprets the phrase "with means to" recited in the claim to be lacking the proper "means plus" functional language structure; and therefore fails to invoke 35 U.S.C. 112, sixth paragraph. Dalseide also discloses each holding body (30,32) being formed with means to prevent mutual twisting. The examiner interprets the phrase "means to prevent" recited in the claim to be lacking the proper means (or step) for-plus-functional-language; and therefore fails to invoke 35 U.S.C. 112, sixth paragraph.

6. In regards to Claim 2, Dalseide discloses a Device according to claim 1, characterized in that the means comprises that each plate element is deformed. The examiner interprets the phrase "characterized in that the means comprises" recited in the claim to be lacking the proper means (or step) for-plus-functional-language; and therefore fails to invoke 35 U.S.C. 112, sixth paragraph.

7. In regards to Claim 7, Dalseide discloses each holding body (30,32) being shaped with means to prevent mutual twisting. The examiner interprets the phrase "with each holding body (30,32) being shaped with means to prevent mutual twisting" to be lacking the proper means (or step) for-plus-functional-language; and therefore fails to invoke 35 U.S.C. 112, sixth paragraph.

8. In regards to Claim 8, Dalseide discloses a device according to claim 7, characterized in that the means comprises that each plate element is deformed. The examiner interprets the phrase "characterized in that the means comprises" recited in the claim to be lacking the means (or step) for-plus-functional-language; and therefore fails to invoke 35 U.S.C. 112, sixth paragraph.

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 2, 7 and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dalseide (US Patent No. 4,654,938).

Regarding Claim 1 Dalseide discloses a device of a descaler head with circumferentially following and longitudinally following rows of descaler parts (32, 33) where the descaler head comprises:

a shaft (15) onto which a number of holding elements (30) for the descaler parts (32, 33) are fed, said holding bodies are held together in the axial direction with the help of adjustable gripping appliances (34, 35) on the carrier shaft (15), and each descaler part is connected to associated holding bodies via connecting means (31) which each is in the form of a relatively short length of chain, piece of wire or similar flexible connecting means, at a distance from the axis of rotation of the descaler head, characterized in that each holding body (30) is formed by two mutually separated plate-formed elements (30), with the descaler elements (32, 33) being held in between the plate elements of the holding body with mutual distance along their periphery, with each holding body (30) being formed with means to prevent mutual twisting (34, 35 and top portions of the plates) in relation to the adjoining holding bodies (Col 3, Lines23-43, Figs. 3, #'s 15, 30, 31, 32, 33).

Note, the examiner interprets the embodiment shown in Fig. 3 of the Dalseide reference to be a cross-sectional view of an embodiment that is structurally similar to the embodiments of Figs. 1 and 2 of the Dalseide reference. The examiner interprets the holding elements (30) to be individual spaced plates of a single mutually spaced plate of the type (10) as shown in Fig. 1 and type (20) as shown in Fig. 2 of the Dalseide reference.

Regarding Claim 7 Dalseide discloses a device of holding elements for descaler part (32, 33) of a descaler head, characterized by two mutually separated plate-formed elements (30), where the descaler elements (32, 33) are arranged held in between the plate elements of the holding body with mutual distance along their periphery, with each holding body (30) being shaped with means to prevent mutual twisting of a holding body (34, 35 and top portions of the plates) in relation to the adjoining holding bodies (Col 3,

Lines 32-43, Fig. 3, #'s 15, 16, 17, 30, 31, 32, 33, and 36).

Regarding Claim 2 Dalseide discloses a device according to claim 1, characterized in that the means comprises that each plate element is deformed so that the row of descender parts (32, 33) along the periphery makes an arch shape/spiral shape, or is placed inclined in relation to the peripheral rotation of the head (Col 3, Lines 44-56, Fig. 4, #'s 30-33, 34, 37).

Regarding Claim 8 Dalseide discloses a device according to claim 7, characterized in that the means comprises that each plate element is deformed so that the row of descender parts (32, 33) along the periphery form an arch shape/spiral shape, or is arranged inclined, in relation to the peripheral rotation of the head (Col 3, Lines 44-56, Fig. 4, #'s 30-33, 34, 37).

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent No. 5,150,506; DE Patent No. 4040536; JP Patent No 2000288848; JP Patent No. 2000354917; JP Patent No. 03-249008; JP Patent No. 06-080228.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patent Examiner whose telephone number is (571) 270-7739. The examiner can normally be reached on M-F, 8am-5:00pm (alternate Fridays off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Ortiz can be reached on (571) 272- 1206. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA).

/Bayán Salone/

*/Angela Ortiz/  
Supervisory Patent Examiner, Art Unit 4151*